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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,471	01/28/2004	Hirokazu Sawada	Q78015	9438

23373 7590 09/19/2006

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,471

Applicant(s)

SAWADA ET AL.

Examiner

Barbara L. Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7,8,10-12,14-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 7, 8, 10-12, 14-17,19-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed July 30, 2006 has been entered and fully considered.
2. Claims 1, 3, 5, 7, 8, 10-12, 14-17, 19-20. Applicant canceled claims 2, 4, 6, 9, 13, 18 and 21.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 5, 7, 8, 10-12, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over NISHIKAWA et al. (EP 211 574 A1).

a. The aluminum alloy support for lithographic printing plates of Nishikawa et al. anticipates the presently claimed aluminum alloy support. The aluminum alloy support of Nishikawa et al. is produced by cold rolling an aluminum alloy has a thickness of 0.1 to 0.5 mm and is composed substantially of 0.05 to 3% Mg, 0.05 to 0.7% Si, 0.01 to 0.25% Zr, 0.05 to 0.4% Fe (abstract; claims; column 4, lines 39-58) with Cu, Zn and Ti as unavoidable impurities in an amount up to about 0.05 % (column 3, line 30 – column 4, line 36). The aluminum alloy plate has a purity of 95.6% or more based on the maximum amount of metals and impurities. The amount of 0.05 to 3% Mg is close to Applicant's claimed range of less than 0.05 wt%. According to the MPEP, a

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prima facie case of obviousness exists where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Therefore absent any critical data, it is the Examiner's position the range of less than 0.5 wt% Mg is obvious in view of the prior art teachings. The aluminum alloy support of NISHIKAWA et al. is then provided with a photosensitive layer (column 6, lines 9-13).

5. Claims 1, 3, 5, 7, 8, 10-12, 14-17, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over HOTTA et al. (EP 1 013 469 A1) in view of NISHIKAWA et al. (EP 211 574 A1).

a. HOTTA et al. teach a process for the preparation of a photosensitive lithographic printing plate. A positive working composition is coated on a support [0059], exposed to light and then subjected to development [0096] which is preferably an alkaline aqueous solution containing at least one saccharide [0097]-[0110]. The support is an aluminum plate can be made of pure aluminum or aluminum alloy comprising aluminum as a main component and a slight amount of foreign elements such as silicon, iron, copper and titanium [0009]. These foreign elements are present in an amount of not greater than 10%, however HOTTA et al. do not specifically disclose how much of each foreign element is preferable. Based on the teachings of NISHIKAWA et al., it would have been obvious to use an aluminum alloy support containing of 0.05 to 3% Mg, 0.05 to 0.7% Si, 0.01 to 0.25% Zr, 0.05 to 0.4% Fe and up to 0.05% Cu (abstract; claims; column 4, lines 39-58; column 3, line 30 – column 4, line

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36) with reasonable expectation of obtaining an alloy with high mechanical strength and excellent water retention based on the teachings of Nishikawa et al. - abstract.** The aluminum alloy plate of NISHIKAWA et al. has a purity of 95.6% or more based on the maximum amount of metals and impurities. The amount of 0.05 to 3% Mg is close to Applicant's claimed range of less than 0.05 wt%. According to the MPEP, a *prima facie* case of obviousness exists where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Therefore absent any critical data, it is the Examiner's position the range of less than 0.5 wt% Mg is obvious in view of the prior art teachings.

**The cited references teach various characteristics presently claimed however, it is the Examiner's position the aluminum alloy supports of the cited references inherently have the same characteristics because of the supports contain the same elements in at least overlapping amounts. Applicant is reminded of MPEP 2112 and 2112.01: "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products

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of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Response to Arguments

6. Applicant's arguments, filed July 30, 2006, with respect to the obviousness-type double patenting rejections and the rejection under 35 USC 102(b) over NISHIKAWA (EP 211 574 A1) have been fully considered and are persuasive. Accordingly, the rejections are withdrawn.

7. Applicant's arguments with respect to the rejection under 35 USC 103(a) over HOTTA et al. (EP 1 013 469 A1) in view NISHIKAWA et al. (EP 211 574 A1) have been fully considered but they are not persuasive.

a. Applicant argued that NISHIKAWA et al. may be considered as teaching away from a plate having Mg of less than 0.05 wt% as required in the present invention based on the teaching at column 3, lines 38-40 that with Mg less than 0.05 wt% and Si less than 0.05 wt%, the alloy plate does not have the required strength. The Examiner respectfully disagrees. This property is observed by NISHIKAWA et al. when both Mg and Si are less than 0.05 wt%. Additionally, the claims are now rejected under 35 USC 103(a) over NISHIKAWA et al. and HOTTA et al. in view of NISHIKAWA et al. Again according to the MPEP, a *prima facie* case of obviousness exists where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in

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the art would have expected them to have the same properties. Therefore absent any critical data, it is the Examiner's position the range of less than 0.5 wt% Mg is obvious in view of the 0.05 to 3% Mg range taught by NISHIKAWA et al.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Barbara L. Gilliam

Barbara L. Gilliam
Primary Examiner
Art Unit 1752

bg
September 15, 2006